REMARKS

Claims 1-25 are pending in the application. Claims 1, 13, 20, and 25 are independent claims. This amendment amends claim 1 and replaces claim 25 with new claim 26.

Claim 1 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject which applicant regards as the invention. Claim 1 has been amended to clarify the meaning of the claim and to correct the antecedent basis problem which was inadvertently introduced by the last amendment. The limitation "integral" has been removed as it was not clear what was meant by the term and, as explained below, it is not needed to distinguish over the art. The amendments to claim 1 do not make it narrower in scope and, in fact, restore it to the breadth of the originally filed claim 1.

With regard to claim 1, the Examiner states that the phrase "creating an other than text portion of the document" is unclear. The intention of the last amendment to claim 1 was to clarify that the authoring component referred to in the claim is used to create content which is not text. This distinguishes from a teaching of an authoring program which allows the pasting of non-text content into an otherwise text document. For example, an email component which allows the author to paste graphic images into an otherwise

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text document would not infringe claim 1. However, an email
component which allows the author to edit graphic images and send
the images as email messages would infringe claim 1. The
amendments made to claim 1 herein are intended to clarify this
meaning. It should also be noted at this point that the claimed
authoring and reading components may be separate components for
authoring and for reading or combination components which allow
both authoring and reading of particular types of message content.

With regard to claim 3, the Examiner states that "...the
group consisting of a game..." lacks antecedent basis.
Presumably, the Examiner would prefer that the phrase read "a
group consisting of...". It is respectfully submitted, however,
that the language "the group consisting of..." is the standard
language used to introduce a Markush group. See, e.g., MPEP
2173.05(h), reproduced in part below.

> 2173.05(h) Alternative Limitations
> I. MARKUSH GROUPS
> Alternative expressions are permitted if they present no
> uncertainty or ambiguity with respect to the question of
> scope or clarity of the claims. One acceptable form of alternative
> expression, which is commonly referred to as a
> Markush group, recites members as being "selected from
> the group consisting of A, B and C." See Ex parte
> Markush, 1925 C.D. 126 (Comm'r Pat. 1925). [Emphasis Added]

Claims 1, 2, 10, 11, 14, 20, and 25 stand rejected under 35
U.S.C. §103(a) as obvious over Fleming in view of Mosher.

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This rejection is respectfully traversed on the following grounds: the amendment to claim 1 makes clear that the stationary tool in Fleming is not an authoring component as claimed herein and that Mosher does is not Internet compatible.

As mentioned above, an authoring tool according to the invention is a tool that allows the user to create/edit content. Claim 1 is intended to claim an authoring tool which allows the user to create/edit content other than text. This is not the same as creating a document which includes content other than text. Fleming may teach pasting a graphic into a text document but Fleming does not teach creating or editing the graphic. Moreover, it should be noted that this "stationary" feature is a "one trick pony". It allows a graphic to be sent as an email attachment and displayed as a background to the text and that is all.

Mosher teaches creating forms in an email client but these forms cannot be sent via the Internet to another email client. In order for the Microsoft Outlook e-mail client to receive a recognizable form, the sending e-mail client and the receiving e-mail client must be connected to the same Microsoft e-mail server. It is respectfully submitted that the Mosher document relates to technology described in U.S. Patent Number 6,035,327[1] which was

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[1]While the Applicant was researching the art to respond to the Examiner's rejection, she uncovered several documents which will be submitted shortly in a Supplemental Information Disclosure Statement. It is believed that the Supplemental IDS should reach the Examiner's desk simultaneously with this amendment.

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filed on December 8, 1997. Microsoft's proposed solution to the
text limitation of the Internet was not to make non-text messages
Internet compatible, but rather to change the Internet.

It is well known that Internet email was originally designed
to handle text messages only. In the words of Microsoft in
December 1997:

> "For example, until recently the Internet
> supported only plain text messaging. In
> contradistinction, many corporate LANs and
> other networks supported a wide variety of
> rich text and other formatting features and
> allowed a wide variety of information to be
> exchanged among users." Col. 1, line 53 et
> seq. of the '327 patent.
>
> "[M]any networks allow users to define
> information that is carried along as part of
> an email message in one or more custom data
> fields. Such custom information is lost when a
> message is transferred over the Internet due
> to the lack of support for custom information
> in the STMP protocol and the 822 mail
> message." Col. 2, line 39 et seq. of the '327
> patent.

From the foregoing, it should be apparent that at the time
the Mosher document was published, Microsoft was telling the
patent office that non-text content would be lost when mail is
sent over the Internet. In particular, the "custom data fields"
taught by Mosher would be lost if mail were sent over the
Internet.

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An object of the '327 patent is to overcome this limitation
which prevents the non-text content created with Outlook from
being carried over the Internet. Microsoft's solution to the
problem was to change the Internet. The '327 patent proposes
adding certain extensions to the SMTP protocol so that Outlook e-
mail containing non-text content can be carried over the Internet
without losing the non-text content. This is not making Outlook
e-mail Internet compatible. It is making the Internet Outlook
compatible. It should be appreciated that the Microsoft solution
proposed in December 1997 would have required alterations to every
e-mail server on the Internet. The present invention does not
require any changes to the Internet. The present invention uses
the Internet as is to send documents containing non-text
information without losing any information in transit.

Claims 2, 10, and 11 depend from claim 1 and the arguments
made above apply to these claims as well.

Claim 14 depends from claim 13 which is not mentioned in the
rejection at paragraph 9 of the Office Action. It is assumed that
the Examiner intended to reject claim 13 in this paragraph since
claim 14 includes all of the limitations of claim 13. As for
claim 13 (and claim 14 which depends from it), the claim requires
means for determining whether the user of the software is a
teacher or a student. The specification illustrates many
applications where this ability is useful. It is respectfully

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submitted that the prior art does not teach or suggest making any distinction between teachers and students.

Claim 20 is of similar scope to claim 1 and the arguments made above apply to this claim as well.

Claim 25 has been replaced with new claim 26. New claim 26 claims in particularity how the invention works to automatically determine which reading component is to be used to read a message. It should be noted that Fleming and Mosher only teach one reading component and thus have no need to encode a message type to distinguish among a plurality of possible reading components.

Claims 3, 4, 8, 9, 12, 15, 16, 21, and 22 stand rejected under 35 U.S.C. §103(a) as obvious over Fleming in view of Mosher in view of Wolf et al.

Claims 3, 4, 8, 9, and 12 depend from claim 1 and thus include all of the limitations of claim 1 are included in these claims. In particular they include the limitation that the e-mail containing non-text content be Internet compatible.

It has been established in the remarks made above that as of 1997 Microsoft mail containing non-text would have the non-text portion removed when sent over the Internet. The e-mail described

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in the Wolf et al. patent suffers from this same problem since the Wolf et al. disclosure was made in 1996 by Microsoft.

Claims 15 and 16 depend from claim 13 and the arguments made above regarding claim 13 apply to claim 15 and 16 as well. Further with regard to claims 15 and 16, it is submitted that the prior art does not disclose any of the authoring components claimed in these claims.

Claims 21 and 22 depend from claim 20 and the remarks made above regarding claim 20 apply to these claims as well.

Claim 13 stands rejected under 35 U.S.C. §103(a) as obvious over Fleming.

Claim 13 claims that an authoring component includes means for determining whether the user is a teacher or a student. This is not the same as distinguishing between author and reader because students can send and receive e-mail to and from teachers. Nor is this the same as a user looking at the name of an email author and determining whether the author is a teacher or a student. Claim 13 requires that an authoring component include means for determining whether the user is a teacher or a student. This feature allows teachers to have access to certain authoring features which are not available to students and vice/versa if desired.

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Claims 5-7, 17-19, 23, and 24 stand rejected under 35 U.S.C. §103(a) as obvious over Fleming in view of Mosher further in view of Hong et al.

These claims all depend from claims discussed above and to that extent the remarks made above regarding claims 1, 13, and 20 apply to these claims as well. Furthermore, the fact that Hong et al. utilizes the MIME standard to one end does not teach or suggest using that standard to achieve the results of the invention which clearly were not possible at the time Hong et al. was filed, i.e. sending an e-mail with non-text content over the Internet without losing the non-text content.
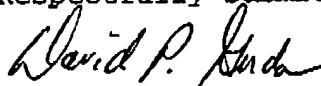
In responding to this rejection, the Applicant wishes to state that the references cited are not admitted to be prior art. It is possible that the Applicant could swear behind the references. However, in view of the clear differences between the claimed invention and cited references it is believed that the tedious task of swearing behind is not necessary.

An attorney for the Applicant spoke today by telephone with the Examiner. The Examiner agreed in principle that the distinction between pasting a graphic and creating/editing a graphic was a significant distinction over Fleming. The Examiner also agreed to hold a personal interview with an attorney for the Applicant should he not be prepared to allow all of the claims in

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light of this Amendment. The Examiner further agreed to telephone the Applicant's attorneys upon receipt of this Amendment so that such a personal interview could be scheduled if needed.

In light of all of the above, it is submitted that the claims are in order for allowance, and prompt allowance is earnestly requested. Should any issues remain outstanding, the Examiner is invited to call the undersigned attorney of record so that the case may proceed expeditiously to allowance.

Respectfully submitted,

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